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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,437	12/28/2001	Keith A. Riha	TRM TR000024 DIV	9561

7590

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EXAMINER

STACOVICI, STEFAN

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 04/03/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/033,437

Applicant(s)

RIHA ET AL.

Examiner

Stefan Staicovici

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 July 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because form and legal phraseology often used in patent claims, such as "comprising" (see page 22, line 1). It is suggested to replace "comprising" with "including." Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 2, it is unclear whether the skin is colored or the outer skin surface is colored. It should be noted that for the purpose of examination it has been assumed that the skin includes a colored outer skin surface. Further clarification is required.

Claim Rejections - 35 USC § 102/103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as anticipated by EP 0 771 695 A1 or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 0 771 695 A1 in view of Spanjer (US Patent No. 4,654,290).

EP 0 771 695 A1 teaches the claimed process including, providing a colored skin material for an automotive trim component and using a laser to form an identifiable mark that has a different color (see col. 2, lines 5-10). It is submitted that the color of the polymeric material changes due to interaction with the laser light in order to form an identifiable mark that has a different color.

However, even if the color of the polymeric material changes due to interaction with the laser light in order to form an identifiable mark that has a different color is not inherently in the teachings of by EP 0 771 695 A1, Spanjer ('290) teaches that a polymeric material that includes a pigment die changes color upon interaction between said pigment die and a laser beam and forms a marking of a different color than the surrounding material (see col. 1, lines 52-60). Furthermore, it is submitted that the polymeric material of Spanjer ('290) includes a skin layer in which the laser beam is focused in order for the inventions of Spanjer ('290) to function as

described. Therefore, it would have been obvious for one of ordinary skill in the art to have formed a color distinguishable mark due to interaction with the laser light as taught by Spanjer ('290) in the automotive interior trim panel of EP 0 771 695 A1, because EP 0 771 695 A1 specifically teaches forming a laser marking having a different color than the surrounding area, whereas Spanjer ('290) teaches that a laser marking is formed in a colored polymeric layer by interaction of the laser beam and a pigment die in the polymeric material. Furthermore, it should be noted that because both references teach laser marking a colored polymeric layer by forming a color distinguishable mark, hence teaching similar processes and solving a similar problem, then to one of ordinary skill in the art, similar effects are to be expected.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Spanjer (US Patent No. 4,654,290) in view of EP 0 771 695 A1.

Spanjer ('290) teaches the basic claimed method of marking a colored polymeric material using a laser including, providing a pigment die in the polymeric material, said pigment changing color upon interaction with a laser beam, and as such forming a marking of a different color than the surrounding material (see col. 1, lines 52-60). It is submitted that the polymeric material

includes a skin layer in which the laser beam is focused in order for the invention of Spanjer ('290) to function as described.

Regarding claim 1, Spanjer ('290) does not teach a skin material for an automotive interior trim panel. EP 0 771 695 A1 teaches a skin material for an automotive trim component including a skin portion and using a laser to form an identifiable mark that has a different color (see col. 2, lines 5-10). Therefore, it would have been obvious for one of ordinary skill in the art to have formed a color distinguishable mark in the automotive interior trim panel of EP 0 771 695 A1 using the process of Spanjer ('290), because EP 0 771 695 A1 specifically teaches forming a laser marking, whereas Spanjer ('290) teaches that a laser marking is formed in a colored polymeric layer by interaction of the laser beam and a pigment die in the polymeric material and also because, both references teach laser marking a colored polymeric layer by forming a color distinguishable mark, hence all references teaching similar processes and solving a similar problem. Further, it should be noted that the limitation of an "automotive interior trim panel" is a recitation of an intended use of the claimed process and it must result in a structural difference between the claimed process and the prior art in order to patentably distinguish the claimed invention from the prior art. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefan Staicovici, Ph.D. whose telephone number is (703) 305-0396. The examiner can normally be reached on Monday-Friday 8:00 AM to 5:30 PM and alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard D. Crispino, can be reached at (703) 308-3853. The fax phone number for this Group is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Stefan Staicovici, PhD



Primary Examiner

4/1/03

AU 1732

April 1, 2003